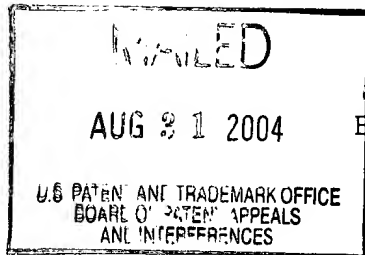


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRAD BAKER

Appeal No. 2004-1953
Application No. 09/607,313

ON BRIEF

Before KIMLIN, GARRIS and DELMENDO, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claim 29, the only claim remaining in the present application. Claim 29 is reproduced below:

29. A confectionary set comprising
- a paint brush having a non-edible handle portion and an edible bristle portion;
- a container in the form of a cylindrical can with a rim surrounding a top opening, said rim including lid engagement means for securing a lid on said container so as to close the container;

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a lid having can engagement means for mating with said lid engagement means to form a seal between said lid and can at least at the time of sale of the confectionery set;

a flowable confectionery disposed within the lid-enclosed container at the time of sale of the confectionery set and extractable by wetting and dipping said paint brush edible portion in said confectionery; and

a paint brush holder attached to said container.

The examiner relies upon the following references as evidence of obviousness:

| | | |
|----------|-----------|---------------|
| Kern | 4,547,926 | Oct. 22, 1985 |
| Gramlich | 5,960,946 | Oct. 5, 1999 |

"Paint Pop" brochure, distributed by B.I.P. Holand B.V. 1996

Appellant's claimed invention is directed to a confectionery set, or a novelty candy, comprising a paint brush having edible bristles, a cylindrical can having a flowable confectionery disposed therein, a closable lid for sealing the can, and a paint brush holder attached to the can. The set allows a person to lick the edible bristles of the brush and then dip the bristles in the can to gather the flowable confectionery.

Appealed claim 29 stands rejected under 35 U.S.C. § 112, first paragraph, description requirement. The claim also stands rejected under 35 U.S.C. § 103 as being unpatentable over the "Paint Pop" brochure in view of Kern and Gramlich.

We have thoroughly reviewed the respective positions advanced by appellant and the examiner. In so doing, we find that the examiner's § 112, first paragraph rejection is well-founded. However, we also find that the examiner has not established a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's § 103 rejection.

We consider first the examiner's rejection under § 112, first paragraph. We concur with the examiner that the claim recitation "a paint brush holder attached to said container" does not find descriptive support in the original specification which, of course, includes the drawings. Appellant relies upon the specification disclosure at page 11, second paragraph, which states:

Figs. 14a and 14b show illustrations of a brush **10** and a can **18**. The brush **10** and can **18** are connectable through packaging **78** such as, but not limited to, shrink-wrap, adhesive or other packaging as shown in Fig. 14c, which comprises a finite length cylinder **80** connected to a finite length hollow tube section having a substantially rectangular cross section **82**. The packaging **78**, as shown in Fig. 14c, cooperatively receives can **18** and brush **10**.

We agree with appellant that feature **82** is described as a hollow tube section which receives paint brush **10**, but tube **82** is not attached to the container in which the flowable confectionery is

disposed, as required by claim 29. Appellant's Figure 14 depicts tube **82** attached to cylinder **80** which receives the claimed can **18** which houses the flowable confectionery. While appellant emphatically repeats the argument that Figure 14 illustrates that brush holder **82** is attached to a container, this is true only to the extent that the container is cylinder **80** which is used to contain can **18** which holds the confectionery. Appellant seems to understand that tubular holder **82** is not attached to the claimed can by saying "[w]hat does 'assembly piece' mean, if **82** is a brush and cylinder **80** is a can?" (page 2 of Reply Brief, first paragraph). What appellant apparently does not understand is that claim 29 calls for brush holder **82** to be attached to the container which is the can that holds the flowable confectionery.

The examiner's § 103 rejection is not sustainable because the examiner fails to make the case that the collective teachings of the applied references would have made the claimed holder attached to the container obvious to one of ordinary skill in the art. Although it is fundamental that every claim recitation must be considered in formulating a rejection under § 102 or § 103, including claim recitations that constitute new matter, i.e., claim limitations which do not have original descriptive support in the specification, the examiner reasons that it is not

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necessary for the prior art to show the claimed brush holder attached to the container. The examiner states that "[w]ith respect to the limitation of 'a paint brush holder attached to the container', it is not clear what this structure is because there is no disclosure of a separate holder or a showing of a separate holder in the specification" (sentence bridging pages 3 and 4 of Answer). In response to appellant's argument that a brush holder is not shown, the examiner repeats that "the specification does not disclose a paint brush holder attached to the container" (page 8 of Answer, first paragraph, penultimate sentence). Consequently, it is clear that the examiner has improperly concluded that it is unnecessary for the prior art to teach or suggest the claimed "paint brush holder attached to said container."

In conclusion, based on the foregoing, the examiner's rejection under § 112, first paragraph is sustained, whereas the examiner's § 103 rejection is reversed. Accordingly, the examiner's decision rejecting the appealed claims is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED


EDWARD C. KIMLIN)
Administrative Patent Judge)


BRADLEY R. GARRIS)
Administrative Patent Judge)


ROMULO H. DELMENDO)
Administrative Patent Judge)

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